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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,564	12/18/2001	Jyrki Hoisko	413-010737-US(PAR)	2681
2512	7590	06/15/2005	EXAMINER	
PERMAN & GREEN			NGUYEN, DAVID Q	
425 POST ROAD			ART UNIT	PAPER NUMBER
FAIRFIELD, CT 06824			2681	

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/023,564	HOISKO ET AL.
Examiner	Art Unit	
David Q. Nguyen	2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 13 May 2005.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-36 is/are pending in the application.  
4a) Of the above claim(s) 24-31 and 32-36 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-23 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All   b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly submitted claims 32-36 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Original claims 1-31 are directed to hearing a musical composition representing the affective state of the sender of the message.

The newly submitted claims 32-36 are directed to means for setting a musical composition to be heard in the receiving communication device.

The original claims 1-31 never claim or recite means for setting a musical composition and a menu for selecting a musical composition from directory as claimed in the newly submitted claims 32-36.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 32-36 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

3. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the caller and/or called party" in line 2 and "the recipient" in line 5 and "the sender" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Dependent claims 2-16 are rejected for fully incorporating the deficiencies of the base claim from which <sup>they</sup> depend.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonemura (JP 2000-172589) in view of Goldberg et al. (US 6125175).

Regarding claim 1, Yonemura discloses a method for expressing an affective state of the caller and/or called party to the conversation partner in communication by telephone, where the caller and called party send each other messages wherein during the communication, a recipient of a message view emotion image representing the affective state of a sender of the message (see abstract). Yonemura does not mention the recipient of a message hearing a musical composition representing the affective state of the sender of the message. However, Goldberg et al. discloses during the communication, the recipient of a message hearing background sounds such as restaurant sounds, forest sounds, beach sounds, city sounds, etc. (see col. 2, lines 48-54). Examiner takes Official Notice of equivalence of the Goldberg et al. 's background sound

equivalents to the musical composition representing the affective state of the applicants so that the called party knows sender's expressing. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Goldberg et al to the method of Yonemura in order to express the caller's emotion.

Regarding claim 2, the method of Yonemura (JP 2000-172589) in view of Goldberg et al. also discloses wherein the message of caller and called party are speech messages (see col. 1, line 54 to col. 2, line 5; col. 3, lines 9-11 and abstract of Goldberg et al).

5. Claims 3-19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonemura (JP 2000-172589) in view of Goldberg et al. and further in view of Cardina et al (US 6151500).

Regarding claim 3, the method of Yonemura in view of Goldberg et al. does not disclose wherein the communication takes place in a system comprising equipment of an operator switching calls and in which system at least one phone is a cellular phone. However, Cardina et al discloses a system for sending message between caller and called party comprising equipment of an operator switching calls and in which system at least one phone is a cellular phone (see fig. 1 and abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Cardina et al to the method of Yonemura in view of Goldberg et al. in order to provide background sounds in a telephone call between calling party and called party in wireless telecommunication.

Regarding claim 4, the method of Yonemura in view of Goldberg et al. and further in view of Cardina et al also discloses wherein the phone of the caller is a cellular phone (see fig. 1 and abstract of Cardina et al); and the musical composition is attached to the message sent by the

caller (see col. 1, line 64 to col. 2, line 2 and col. 2, lines 44-54 of Goldberg et al). It is apparent that the method of Goldberg et al combined with the method of Cardina et al would suggest or disclose the musical composition is attached to the message sent by the caller in the caller's cellular phone.

Regarding claim 5, the method of Yonemura in view of Goldberg et al. and further in view of Cardina et al discloses wherein the musical composition is transferred together with the message on the same audio channel from the cellular phone of the caller to the phone of the called party (see col. 1, line 64 to col. 2, line 2 and col. 2, lines 44-54 of Goldberg et al).

Regarding claim 6, the method of Yonemura in view of Goldberg et al. and further in view of Cardina et al discloses wherein the phone of the called party is a cellular phone (see fig. 1 and abstract Cardina et al); and the musical composition is attached to the message sent by the caller (see col. 1, line 64 to col. 2, line 2 and col. 2, lines 44-54 of Goldberg et al). It is apparent that the method of Goldberg et al combined with the method of Cardina et al would suggest or disclose the musical composition is attached to the message sent by the caller in the cellular phone of the called party.

Regarding claims 7-9, the method of Yonemura in view of Goldberg et al. and further in view of Cardina et al discloses there is transferred from the caller to the called party an identifier on the basis of which the musical composition is selected; wherein the identifier specifies the name of the musical composition; wherein the identifier specifies the affective state of the caller (see col. 2, lines 45-54 of Goldberg et al); and Cardina et al discloses wherein the phone of the called party and caller are cellular phones (see fig. 1 and abstract Cardina et al). It is apparent that the method of Cardina et al combined with the method of Goldberg et al would disclose or

suggest there is transferred from the cellular phone of the caller to the cellular phone of the called party an identifier on the basis of which the musical composition is selected; wherein the identifier specifies the name of the musical composition; wherein the identifier specifies the affective state of the caller.

Regarding claim 10, the method of Yonemura in view of Goldberg et al. and further in view of Cardina et al also discloses the musical composition is attached to the message sent by the caller in the equipment of the operator switching the call (see col. 1, line 64 to col. 2, line 2 and col. 2, lines 44-54 of Goldberg et al of Goldberg et al).

Regarding claims 11-13, the method of Yonemura in view of Goldberg et al. and further in view of Cardina et al also discloses wherein there is transferred from the cellular phone of the caller to the operator an identifier on the basis of which the musical composition is selected; wherein the identifier specifies the name of the musical composition; wherein the identifier specifies the affective state of the caller (see col. 1, line 64 to col. 2, line 2 and col. 2, lines 44-54 of Goldberg et al of Goldberg et al).

Regarding claim 14, the method of Yonemura in view of Goldberg et al. and further in view of Cardina et al also discloses wherein the phones of the caller and called party are cellular phones (see fig. 1 and abstract of Cardina et al); and from the caller to the called party there is sent a file which contains a musical composition stored in electric form (see col. 1, line 64 to col. 2, line 2 and col. 2, lines 44-54 of Goldberg et al of Goldberg et al). It is apparent that the method of Goldberg et al combined with the method of Cardina et al would suggest or disclose wherein the phones of the caller and called party are cellular phones and from the cellular phone

of the caller to the cellular phone of the called party there is sent a file which contains a musical composition stored in electric form.

Regarding claim 15, the method of Yonemura in view of Goldberg et al. and further in view of Cardina et al also discloses that wherein the musical composition is set to be played on the cellular phone of the called party (see abstract of Goldberg et al).

Regarding claim 16, the method of Yonemura in view of Goldberg et al. and further in view of Cardina et al also discloses that wherein the musical composition is set to be played on a separate sound reproducing apparatus connected to the cellular phone of the called party (see abstract of Goldberg et al).

Regarding claim 17, Yonemura in view of Goldberg et al. disclose a system for expressing an affective state of a caller and/or called party to the conversation partner in communication by telephone, where the caller and called party send each other messages (see col. 1, line 54 to col. 2, line 5; col. 2, lines 44-54 and col. 3, lines 9-11 and abstract); wherein the system further comprises a directory storing musical compositions representing various affective states and a menu for selecting musical compositions in the directory (col. 2, lines 44-54).

Yonemura (JP 2000-172589) in view of Goldberg et al. do not mention the system comprises at least one cellular phone and the equipment of an operator switching calls. However, Cardina et al discloses a system for sending message between caller and called party comprising equipment of an operator switching calls and in which system at least one phone is a cellular phone (see fig. 1 and abstract). It is apparent that the system of Cardina et al combined with the system of Goldberg et al would suggest or disclose the system comprises at least one cellular phone and the equipment of an operator switching calls.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Cardina et al to the method of Yonemura in view of Goldberg et al. in order to provide background sounds in a telephone call between calling party and called party in wireless telecommunication.

Regarding claim 18, the system of Yonemura in view of Goldberg et al. in view of Cardina et al also discloses wherein the musical compositions are stored in the directory in electric form (see col. 2, lines 44-54 of Goldberg et al).

Regarding claim 19, the system of Yonemura in view of Goldberg et al. in view of Cardina et al does not mention wherein the musical compositions are stored in the directory in the form of midi or mp3 files. Official notice taken that the musical compositions are stored in the directory in the form of midi or mp3 files is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of the system of Goldberg et al in view of Cardina et al so that the caller/called party can listen to music in many different formats.

Regarding claim 22, the system of Yonemura in view of Goldberg et al. in view of Cardina et al also discloses wherein the directory is in the equipment of the operator (see col. 2, lines 44-54 of Goldberg et al).

6. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonemura (JP 2000-172589) in view of Goldberg et al. and further in view of Cardina et al (US 6151500) and still in view of Armanto et al (US 6094587).

Regarding claims 20-21, the system of Yonemura in view of Goldberg et al. in view of Cardina et al does not mention wherein the directory is in the cellular phone of the caller;

wherein the directory is in the cellular phone of the called party. However, Armanto et al disclose the directory is in the cellular phone (see abstract fig. 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Armanto et al to the system of Yonemura in view of Goldberg et al. in view of Cardina et al in order to user can change musical composition as desired.

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yonemura (JP 2000-172589) in view of Goldberg et al. and further in view of Cardina et al (US 6151500) and still in view of Makelaet al (US 6501967).

Regarding claim 23, the system of Yonemura in view of Goldberg et al. in view of Cardina et al does not mention wherein the menu is arranged to be at least in the cellular phone of the caller. However, Makelaet al disclose a menu is arranged to be at least in the cellular phone (see abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Makelaet al to the system of Yonemura in view of Goldberg et al. in view of Cardina et al in order to user can change musical composition as desired.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q. Nguyen whose telephone number is 571-272-7844. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOSEPH H. FEILD can be reached on (571)272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*DN*  
David Nguyen



JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER